

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TREND MICRO, INC.

Petitioner

v.

OPEN TEXT INC.

Patent Owner

Inter Partes Review No. 2023-00699

Patent No. 8,418,250

**PETITIONER’S MOTION FOR JOINDER UNDER
35 U.S.C. § 315(C), 37 C.F.R. §§ 42.22, AND 42.122(B)**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Trend Micro, Inc. (“Trend Micro” or “Petitioner”) requests its current Petition for *inter partes* review (IPR2024-00106) of U.S. Patent No. 8,418,250 (“the ’250 Patent”) be granted and joined pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b) with the petition for inter partes review (IPR2023-00699) filed by Sophos Ltd. and Sophos Inc. (“Sophos”) concerning the ’250 Patent (the “Sophos Petition”).¹

Trend Micro’s request for joinder is timely because it is made no later than one month after the October 11, 2023, institution date for the Sophos Petition. Trend Micro’s Petition relies on the references cited and follows the arguments raised in the Sophos Petition and is essentially a copy of the Sophos Petition. It includes identical grounds presented in the Sophos Petition and therefore would create no additional burden for the Board, Sophos, or Webroot, Inc. and Open Text, Inc (collectively “Open Text” or “Patent Owner”) if joined. Joinder would therefore lead to an efficient resolution of the validity of the ’250 Patent.

Trend Micro stipulates that if joinder is granted, Trend Micro counsel will cooperate with Sophos serving in an “understudy” role in the joined proceeding,

¹ While Trend Micro is time-barred under 35 U.S.C. § 315(b) to file a new petition, the current petition and this motion for joinder is not time-barred, because 35 U.S.C. § 315(c) creates an exception from the time bar for purposes of joinder.

whether at hearings, at depositions, in filings, or otherwise, as outlined below. Trend Micro will continue in the understudy role unless Sophos is terminated from the proceedings.² Thus, joinder will not impact the trial schedule. Joinder is appropriate because Trend Micro participation as an understudy will not unduly burden or prejudice the parties to the Sophos IPR while efficiently determining the validity of the instituted claims of the '250 Patent in a single proceeding.

Accordingly, and for the reasons discussed below, joinder should be granted.

II. BACKGROUND AND RELATED PROCEEDINGS

Trend Micro filed a first petition for *inter partes* review of the '250 Patent on March 2, 2023 (IPR2023-00655). The Board denied institution of IPR2023-00655 on October 11, 2023.

The '250 patent is also at issue in the following district court litigations:

² In the event Patent Owner, Open Text, Inc., and/or Sophos move to terminate IPR2023-00699, Patent Owner should not be terminated before this motion is decided. *See MEDIATEK Inc. et al. v. Bandspeed, Inc.*, IPR2015-00314, Paper No 20 at 3 (Sep. 17, 2015) (granting Joint Motion to Terminate with respect to last remaining petitioner, but exercising discretion under “35 U.S.C. § 317(a) to decline, at this time, to terminate these proceedings with respect to Patent Owner” given pending copycat petition with motion for joinder).

Webroot, Inc. and Open Text, Inc. v. Trend Micro Inc., Case No. 6:22-cv-00239 (W.D. Tex.), which was originally filed on March 4, 2022; *Webroot, Inc. and Open Text, Inc. v. Sophos LTD.*, Case No. 6:22-cv-00240 (W.D. Tex.), which was originally filed on March 4, 2022; *Webroot, Inc. and Open Text, Inc. v. CrowdStrike, Inc. and CrowdStrike Holdings, Inc.*, Case No. 6:22-cv-00241 (W.D. Tex.), which was originally filed on March 4, 2022³; and *Webroot, Inc. and Open Text, Inc. v. AO Kaspersky Lab*, Case No. 6:22-cv-00243 (W.D. Tex.), which was originally filed on March 4, 2022.

III. ARGUMENT

The Board may join any person who properly files a petition for *inter partes* review to a separate, ongoing *inter partes* review. 35 U.S.C. § 315(c). A petition that seeks joinder must be timely filed “no later than one month after the institution date of any inter partes review for which joinder is requested.” 37 C.F.R. § 42.122(b).

A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. See *Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 2-4 (PTAB Apr. 24, 2013).

³ The *CrowdStrike* district court proceedings were recently dismissed.

Trend Micro's motion is timely, and the Board should grant joinder because consideration of the foregoing *Kyocera* factors weighs in favor of joinder.

A. Trend Micro's Motion for Joinder Is Timely

Joinder may be requested "no later than one month after the institution date of any inter partes review for which joinder is requested." 37 C.F.R. § 42.122(b). Sophos's Petition was instituted on October 11, 2023. *Sophos*, IPR2023-00699, Paper 9 (Oct. 11, 2023). Trend Micro's motion is timely as it is being filed within one month of the institution date, the time set by 37 C.F.R. § 42.122(b).

B. The *Kyocera* Factors Weigh in Favor of Joinder

Each of the four factors that the Board considers in motions for joinder favor granting of Trend Micro's motion. As shown below, joinder will not add further complication to the proceedings or cause prejudice to the parties.

1. Joinder of Trend Micro is appropriate because it will promote an efficient determination of the validity of the '250 Patent without prejudice to any party.

If Trend Micro is joined as a party, the validity of the grounds raised in the Sophos Petition and Trend Micro's Petition can be determined in a single proceeding. Trend Micro's current Petition challenges the validity of the same claims of the '250 Patent on identical grounds to those in the Sophos Petition. There are no material differences between the substance of Sophos's and Trend Micro's Petitions. Trend Micro also relies on the same supporting evidence in its Petition, including the same expert witness, as is relied on in the Sophos Petition. A

consolidated proceeding, including Sophos and Trend Micro, will therefore more efficiently “secure the just, speedy, and inexpensive resolution” of Trend Micro’s current Petition and Sophos’s Petition in a single proceeding, as compared with two separate proceedings. 37 C.F.R. § 42.1(b).

Joining Trend Micro as a party to the Sophos IPR also would not cause any prejudice to either Sophos or Open Text. Open Text, as the patent owner, must respond to the invalidity grounds identified in Sophos’s Petition, which are identical to those set forth in Trend Micro’s current Petition. Additionally, Trend Micro’s current petition relies on a declaration from the same expert as relied on in the Sophos petition, so joining Trend Micro will not impact Open Text’s discovery. Thus, Open Text would bear no additional burden as result of joinder. For both Sophos and Open Text, Trend Micro’s current Petition has been filed sufficiently early so that joinder would affect neither the potential schedule of the *inter partes* review, nor the costs associated with a full trial, particularly in view of Trend Micro stipulating to participate as an understudy to Sophos. This factor favors joinder.

2. Trend Micro’s petition does not raise any new grounds of unpatentability and therefore does not add additional complexity to the grounds in Sophos’s petition.

Trend Micro’s Petition challenges the validity of the ’250 Patent on identical grounds to those in the Sophos Petition. *See Sophos*, IPR2023-00699, Paper 1 (Mar. 8, 2023). Trend Micro’s supporting materials, including its supporting expert

declaration, are also the same as those presented by Sophos. Therefore, consolidation of this proceeding with Sophos's via joinder of Trend Micro's Petition will not raise any new issues of unpatentability and will not impose any additional burden on the Board or add additional complexity to the case. The Board has granted joinder in similar situations. *See, e.g., Hyundai Motor Co. v. Am Vehicular Scis. LLC*, IPR2014-01543, Paper 11 at 2-4 (PTAB Oct. 24, 2014); *Sony Corp. of Am. v. Network-1 Sec Solutions, Inc.*, IPR2013-00495, Paper 13 at 4-9 (PTAB Sept. 16, 2013); *Dell Inc. v. Network-1 Solutions, Inc.*, IPR2013-00385, Paper 17 at 6-10 (PTAB July 29, 2013); *Motorola Mobility LLC v. SoftView LLC*, IPR2013-00256, Paper 10 at 3-10 (PTAB June 20, 2013). This factor also favors joinder.

3. Joinder would not affect the schedule in the Sophos IPR.

Given that the Board instituted review of the Sophos Petition less than a month ago, joinder of the Trend Micro Petition would not affect the schedule in any forthcoming trial. Trend Micro's participation would result in no changes to the schedule. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]"). This factor further favors joinder.

**4. Joinder will not complicate briefing or discovery because
Trend Micro agrees to consolidated filings and an
understudy role.**

Trend Micro agrees to take an “understudy” role in the joined proceeding, absent termination of Sophos as a party. Trend Micro agrees that in the joined proceeding, the following conditions shall apply so long as Sophos remains an active party, as previously approved by the Board in similar circumstances:

- all filings by Trend Micro in the joined proceeding be consolidated with the filings of Sophos, unless a filing solely concerns issues that do not involve Sophos;
- Trend Micro shall not be permitted to raise any new grounds not already instituted by the Board, or introduce any argument or discovery not already introduced by Sophos;
- Trend Micro shall be bound by any agreement between Patent Owner and Sophos concerning discovery and/or depositions; and,
- Trend Micro at deposition shall not receive any direct, cross examination, or redirect time beyond that permitted for Sophos in this proceeding alone under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Sophos. See *Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5–6 (Apr. 10, 2015) (finding the proposed limitations “are consistent with the ‘understudy’ role that Petitioner agrees to assume, as well as Petitioner’s

assertion that its presence would not require introducing any additional arguments, briefing, or discovery.”).

Trend Micro would assume a primary role only if Sophos ceased to participate in the proceeding. The Board has consistently found that the acceptance of an “understudy” role removes any undue complications or delay that might allegedly result from joinder. *See, e.g., Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 7 (PTAB Oct. 15, 2015); *see also Mylan Pharmas. Inc. v. Dr. Falk Pharma GmbH*, IPR2016-01386, Paper 9 at 6 (PTAB Nov. 30, 2016). This factor also favors joinder.

C. The *General Plastics* Factors Weigh in Favor of Joinder

While Trend Micro filed a petition directed to claims 1-30 of the ’250 Patent on March 2, 2023, and the Board denied that petition on October 11, 2023, that prior petition does not affect joinder here. Trend Micro’s current Petition is a substantial copy of the Sophos Petition filed for the purpose of joining the instituted IPR and involves different grounds and arguments than Trend Micro’s prior IPR2023-00655. Therefore, “road-mapping” concerns are not raised by Trend Micro’s current Petition and this motion for joinder.

Instituting IPR based on Trend Micro’s current Petition and granting this motion for joinder will ensure the Board’s resources are being used to improve patent quality of the ’250 patent by enabling Trend Micro to step in to conclude the instituted IPR in the event that Sophos is no longer a participant in the proceedings.

“The Board’s mission is ‘to improve patent quality and restore confidence in the presumption of validity that comes with issued patents’ outweighs the impact on Board resources needed to evaluate the merits of a petition.” *Oxysales Uab et al*, IPR2022-00861, Paper 18, page 6 (quoting *Cuozzo Speed Techs.*, 579 U.S. at 272). Thus, joinder would ensure the Board can complete its mission for the ’250 patent even if Sophos is no longer a party to the IPR.

Finally, instituting IPR based on Trend Micro’s current Petition and granting this motion for joinder will not delay the IPR proceeding as Trend Micro stipulates to the understudy role as detailed above.

V. CONCLUSION

For the foregoing reasons, Trend Micro respectfully requests that the Board grant its concurrently filed Petition for *inter partes* review of the '250 patent and join Trend Micro with Sophos as Petitioners in IPR2023-00699.

Respectfully submitted,
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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

The undersigned hereby certifies that the above-captioned **MOTION FOR JOINDER** was served in their entirety on November 8, 2023, on the following party via Federal Express to the Patent Owner by serving to the correspondence address of record for the '250 patent:

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